

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed February 16, 2005. At the time of the Office Action, Claims 1-6, 8-14, 16-22, 24-29, and 31 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-6, 8-14, 16-22, 24-29, and 31 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,438,562 issued to Gupta (hereinafter “*Gupta*”) and further in view of U.S. Patent No. 6,330,606 issued to Logue et al. (hereinafter “*Logue*”). Applicant respectfully traverses this rejection for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>1</sup> It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on, at least, the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, Independent Claim 1 recites a method for processing a request that includes “[a] central server comprising information indicating a location of the record that is included within one or more of the database units.” The Examiner has yet to identify any relevant portion of *Gupta* or *Logue* to support these elements. The Examiner concedes in the Office Action that *Gupta* does not include a central server, but the Examiner has proffered *Logue* to fill this void.

At the passage cited by the Examiner in the most recent Office Action for this central server element, *Logue* provides: “When a document request is received from a client, the proxy request processor 410 determines whether to service the request from the document

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<sup>1</sup> See M.P.E.P. §2142-43.



cache 465 by performing a search of the document cache 465. If the document is found locally, then the document may be retrieved from the document cache 465 and transferred to the client with the response. However, if the requested document is not found, then the proxy request processor 410 requests the document from the appropriate site and upon receipt the proxy request processor 410 provides the document to the client with the response. Further, the proxy request processor 410 anticipates subsequent requests by storing the document in the document cache 465.” (See *Logue*: Columns 5, lines 17-29.)

Hence, in the system of *Logue* there is no location information resident on the proxy request processor 410 (which is akin to the central server according to the Examiner’s interpretation of the Claims). In contrast to teachings of *Logue*, the subject matter of the pending claims clearly provides for a central server that is already aware (i.e. before any search is initiated) of the location of information within the database units. This awareness would obviate the need to perform searching operations or to evaluate the contents of a local cache. In contrast to these teachings, the proxy request processor 410 of *Logue* is a somewhat uninformed device, which must perform a search to find the information that it seeks, as it has no way of knowing the location of the data beforehand. The search would ostensibly require additional processing resources and, further, be time-consuming. For this single reason, Independent Claim 1 is distinguishable over *Logue*. Additionally, Independent Claims 9, 17, and 25 include a similar limitation to that identified above and, thus, are also allowable over *Logue* and *Gupta* for similar reasons. In addition, the corresponding dependent claims associated with these Independent Claims are also patentable over these references for analogous reasons.

It is also noted that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Gupta* reference or of the proposed *Logue-Gupta* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Logue*, in *Gupta*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>2</sup> Thus, the sheer

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<sup>2</sup> M.P.E.P. §2143.01 (emphasis in original).



fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>3</sup>

Nothing in *Logue* or in *Gupta* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>4</sup> This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.<sup>5</sup> guidelines and governing Federal Circuit case law.<sup>6</sup> The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.<sup>7</sup> Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”<sup>8</sup> Under such circumstances, the Examiner must point to some concrete evidence in the record in support of

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<sup>3</sup> *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>4</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

<sup>5</sup> See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>6</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>7</sup> See M.P.E.P. §2145.

<sup>8</sup> See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).



the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”<sup>9</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show any potential interoperability of the two systems of *Gupta* and *Logue*: much less a reasonable expectation of success for the proposed combinations, as is required. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Therefore, the Examiner has not satisfied the criteria that is required to support a proper §103 rejection. All of the pending claims have been shown to be allowable over the references of record. Written notice to this effect is respectfully requested from the Examiner in the form of a full allowance of the pending claims.

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<sup>9</sup> See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).



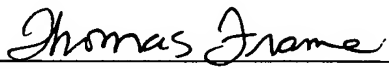
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,  
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Date: April 5<sup>th</sup>, 2005

Customer No. **35005**